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**REMARKS**

Upon entry of this response claims 1-4, 7-9, 12-14, 17-19, and 21-23 remain pending in the present patent application. Claims 1, 7, 8, 12, 13, 17, and 18 have been amended, claims 5-6, 10-11, 15-16, and 20 have been canceled, and claims 21-23 have been added. Applicants request reconsideration of the pending claims in view of the following remarks.

In item 4 of the Office Action, claims 1-4, 8, 9, 13, 14, 18, and 19 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,369,909 issued to Shima (hereafter "*Shima*"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983). Applicants note that claims 1, 8, 13, and 18 have been amended herein to incorporate elements from the canceled claims in the present application that are neither shown nor suggested by *Shima* as will be described below. Accordingly, Applicants request that the rejection of claims 1, 8, 13, and 18 be withdrawn. In addition, Applicants request that the rejection of claims 2-4, 9, 14, and 19 be withdrawn as depending from claims 1, 8, 13, or 18.

Next, in item 5 of the Office Action, claims 5, 10, 15, and 20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Shima* in view of U.S. Patent 6,101,510 issued to Stone et al. (hereafter "*Stone*"), and further in view of U.S. Patent Publication 2003/0041110 filed by Wenocur et al. (hereafter "*Wenocur*"). Applicants note that claims 5, 10, 15, and 20 have been canceled herein, thereby rendering the rejection of these claims moot. Accordingly, Applicants request that this rejection be withdrawn.

In item 6 of the Office Action, claims 6, 11, and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Shima* in view of *Stone* and further in view of *Wenocur* and in further in view of U.S. Patent 5,974,346 issued to Poledna (hereafter "*Poledna*"). Applicants note herein that claims 6, 11, and 16 have been canceled, thereby rendering this basis of rejection moot with respect to such claims. Accordingly, Applicants request that the rejection of claims 6, 11, and 16 be withdrawn.

However, to the extent that claims 1, 8, 13, and 18 have been amended herein to incorporate elements similar in scope with those of claims 6, 11, and 16,

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Applicants discusses the rejection of claims 1, 8, 13, and 18 with respect to the cited references of *Shima*, *Stone*, *Wenocur*, and *Poledna* below.

To begin, claim 1 has been amended as follows:

1. A rendering method, comprising:
  - Identifying an application employed to generate a digital document in a computer system;
  - Identifying a select rendering application from a number of rendering applications in the computer system to render the document into an output file embodied in a predefined file format; and
  - automatically rendering the digital document into the output file embodied in the predefined file format with the select rendering application by:
    - setting a global print setting associated with the select rendering application to print to the output file;
    - generating one of a plurality of instances of the select rendering application to automatically render the digital document into the output file, wherein the instances are executed concurrently; and
    - commanding the one of the instances of the select rendering application to perform a print operation on the digital document.

As set forth above, claim 1 recites the fact that the automatic rendering of the digital document into the output file of the predefined file format with the select rendering application is performed by setting a global print setting associated with the select rendering application to print the output file in generating one of a plurality of instances of the select rendering application to automatically render the digital document into the output file. The plurality of instances are executed concurrently. Also, the one of the instances generated is commanded to perform a print operation on the digital document as recited in claim 1.

As set forth above, claim 1 reflects the fact that the global print settings for the given select rendering application have to be set separately for each instance of the select rendering application that is executed. Thus, to the extent that multiple instances of the application are executed concurrently, then the global print settings are uniquely set for each one of the instances, given that each instance of the rendering application may render a document for printing on a different print device requiring a different print format.

Applicants assert that none of the cited references show or suggest the setting of a global print settings as claims above, where multiple instances of a

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rendering application are executed. Specifically, to do so would cause collisions in the print settings to the extent that a single set of global print settings is employed for multiple instances of an application. That is to say, that an instance of an application to render a document in one format may not be able to do so as the global print settings may have previously been set for a prior instance of the application to render a document in a different format. In this respect, the global print settings are set for each individual instance of the given application. For example, in paragraph 0899, *Wenocur* states as follows:

"A side benefit of having one global variable is that it makes looking at variables in a visual debugger very easy since you only need to have one variable in a watch window and all the terminal variables are organized logically by structure." (*Wenocur*, paragraph 0899, pg. 66.)

This assumes that a single instance of an application is running and therefore, there is no potential collision between the global print settings of multiple instances. If multiple instances of the given application were to be run on the given processor of *Wenocur*, it would not be possible to include a window with a single set of global print settings for all the instances of an application, given that they would collide in changing the variables as described.

In addition, Applicants assert that none of the other references would show or suggest the concept of setting global print settings for multiple instances of an application, where various instances are executed concurrently.

Accordingly, Applicants request that claims 1, 8, 13, and 18 as amended herein be allowed over the cited references. In addition, Applicants request that all of the remaining dependent claims be allowed as depending from claims 1, 8, 13, and 18.

In addition, claims 7, 12, and 17 have been rejected in item 7 of the Office Action under 35 U.S.C. §103(a) as being unpatentable over *Shima* in view of *Stone* and in further view of *Wenocur* and in further view of *Poledna* and in further view of U.S. Patent 6,380,935 issued to Heesch et al. (hereafter "*Heesch*"). Applicants assert that claims 7, 12, and 17 are in condition for allowance for the same reasons described above with respect to claims 1, 8, and 13. In addition, claim 7 as amended provides as follows:

7. The rendering method of claim 1, further comprising synchronizing an initiation of the print operation of the one of the

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instances of the select rendering application with a number of other initiations of print operations for other instances of the select rendering application to prevent a concurrent initiation of the print operation of at least two of the instances of the select rendering application.

In this respect, claim 7 has been amended to recite that the synchronization of the initiation of the print operations of the instances as claimed is performed to prevent a concurrent initiation of a print operation of at least two of the instances of the select rendering application. This is to make sure that no more than one instance is commanded to initiate a print operation after the global print setting has been set to prevent multiple instances from attempting to initiate print operations with the wrong global print settings, thereby resulting in rendering of documents in the wrong print formats.

To the extent that the Office Action relies on *Poledna* as showing or suggesting the elements of claim 7, Applicants respectfully disagree. Specifically, at column 5, lines 19-30, *Poledna* states:

According to FIG. 5, task A wrote the local copy msgx(A) as having the value of zero during its processing. Subsequently, the value of the local copies msgx(A) is again written to the global copy msgx. Again, the write process is not interruptible, as explained in the description of FIG. 4. When task B is processed, the value in the global copy msgx is again taken into the local copy msgx(B), before the critical if-then-else instruction. Then, during further processing of task B, only the local copy msgx(B) is used. Even an interruption by task C, with the global variable msgx being rewritten while that task is processed, will not result in data inconsistency. (*Poledna*, column 5, lines 19-30.)

Applicants simply assert that the statement above with respect to writing values to a "global copy msgx" has nothing to do with writing global print settings in the manner as described in claim 7 above, or in the manner described in claim 1 as amended above. In fact, as written, it is difficult to even figure out what *Poledna* is trying to say at all. Accordingly, Applicants request that the rejection of claim 7 be withdrawn. In addition, Applicants request that the rejection of claims 12 and 17 be withdrawn for at least these additional reasons.

In addition, Applicants object to this motivation to combine the multiple references combined in the present rejection. Specifically, to reject claims 6, 11, and 16, the Office Action combines *Shima*, *Stone*, *Wenocur*, and *Poledna*. In citing motivation to combine, the Office Action states that the system taught by *Shima*

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would be modified as taught by *Wenocur* to include rewriting global settings as taught by *Poledna* because using global settings are more efficient in terms of code size and execution speed as taught by *Wenocur* and allow global settings to be written as taught by *Poledna* which would allow users to modify efficient settings. Mere conclusory statements or mere reference to common knowledge can not be relied upon as motivation to combine or modify references. When general knowledge is relied upon, the "knowledge must be articulated and placed on the record." Also, conclusory statements cannot be relied upon when dealing with particular combinations of prior art and specific claims. Rather, the rejection must set forth the rationale upon which it relies. In re Sang Su Lee, 277 F.3d 1338, 61 USPQ2d 1430, (Fed. Cir. 2002).

Applicants assert that the motivation cited by the present application in combining the multiple references is at best conclusory, and at worst nonsensical with reference to the claims set forth in the present patent application and in lieu of the plain teachings of the cited references. Specifically, *Wenocur* states that the use of global print settings provides for efficiencies as a single point of location of the billable print settings and makes it easier for keeping track of such values. However, the discussion of global settings of *Poledna* has nothing to do with the use of the settings of *Wenocur* in any context. In this respect, Applicants assert that at least these two references have been combined to create the present rejection of the claims by a random selection based upon the finding of specific words in the references after performing a word search and then force fitting other statements in the references to cite motivation to combine, even though the references themselves are unrelated and that it is highly unlikely that one skilled in the art would ever be motivated to combine such references. In this respect, the combination of these references is a classic case of impermissible hindsight construction using the present claims as a blueprint. Where the claims not present to provide a blueprint for use in a hindsight guide to the search for specific terms, it is simply unreasonable to assert that one skilled would find the references cited and make the combination asserted.

Therefore, for the reasons described above, Applicants assert that the motivation to combine is at best a conclusory statement rather than a legitimate motivation to combine that would lead one skilled in the art to make the combination alleged. Accordingly, Applicants request that any rejections in the present

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application based on the above-cited combination of the above-cited references be withdrawn.

### **CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding this Response, the Examiner is encouraged to telephone the undersigned counsel of Applicant.

Respectfully submitted,



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